REMARKS

This is a full and timely response to the outstanding non-final Office Action mailed May 25, 2005. Upon entry of the amendments in this response, claims 1 – 6 and 8 - 20 remain pending. Reconsideration and allowance of the application and presently pending claims are respectfully requested.

Declaration Under 37 CFR 1.131

The Office Action indicates that the previously submitted Declaration under 37 C.F.R. 1.131 is defective. In this regard, Applicants submit herewith a revised Declaration and respectfully assert that the revised Declaration under 37 C.F.R. 1.131 properly indicates the inapplicability of the *Google* reference for rejecting the pending claims.

I. Conception

Specifically, the Declaration indicates that the invention was conceived prior to the effective date (May 23, 2001) of the *Google* reference (*see* Declaration at item 1.). With respect to the features recited in Applicants' claim 1, for example, Exhibits A and B demonstrate conception of at least the following:

A. "identifying an unfamiliar word in the document"

This feature is indicated by the "Standard Spell Check" block in the first diagram of page 4 of Exhibit A. The "Standard Spell Check" block indicates that, in some embodiments of the invention, an unfamiliar word can be identified by a failure to be recognized during a standard spell check. Thus, if the determination in the "Result yes/no" decision block is "no," the word is unfamiliar and further processing is carried out. Note, similar results are shown in the second diagram of page 4 of Exhibit A. Similarly, the textual explanation of

identifying an unfamiliar word (i.e., "after not finding a word. . .") appears in the first paragraph of page 3 of Exhibit A and the first paragraph of Exhibit B.

B. "generating at least one alternative spelling of the unfamiliar word to create a word variant"

This feature is indicated by the "word, variant 1. . ." block in the first diagram of page 4 of Exhibit A. The "word, variant 1. . ." block indicates that, in some embodiments of the invention, one or more variants of the word are generated. Note, similar results are shown in the second diagram of page 4 of Exhibit A, which indicates that a word "outsourser" and a generated word variant "outsourcer" are posted for search. Similarly, the textual explanation of generating at least one alternative spelling of the unfamiliar word to create a word variant (i.e., "will post the unfound word and several derivatives of the word. . .") appears in the first paragraph of page 3 of Exhibit A and the first paragraph of Exhibit B.

C. "providing the unfamiliar word and the at least one word variant to a search engine configured to search for a frequency of use of the unfamiliar word and the at least one word variant"

This feature is indicated by the "word, variant 1. . ." and "Post word(s)" blocks in the first diagram of page 4 of Exhibit A. These blocks indicate that, in some embodiments of the invention, one or more variants of the word are generated and provided to a search engine. The next block, i.e., the "Order results" block, indicates that the number of hits for the searched words are used. This correlates to the frequency of use of the unfamiliar word and the at least one word variant. Note, similar results are shown in the second diagram of page 4 of Exhibit A, which indicates that a word "outsourser" and a generated word variant "outsourcer" are posted for search, and the corresponding hits are used. Similarly, the textual explanation of providing the unfamiliar word and the at least one word variant to a search engine configured to search for a frequency of use of the unfamiliar word and the at least one

word variant (i.e., "will post the unfound word and several derivatives of the word to an Internet search engine. . . based on the number of search results") appears in the first paragraph of page 3 of Exhibit A and the first paragraph of Exhibit B. Additionally, the teaching of "This process for checking a word based on its "Internet popularity" allows a spell checker to have a recommendation for almost any word. . ." appears in the second paragraph of page 3 of Exhibit A and the second paragraph of Exhibit B.

D. "presenting information corresponding to the frequency of use of the unfamiliar word and the at least one word variant to the user"

This feature is indicated by the "Order results" block, which indicates that the number of hits for the searched words are used. This correlates to the frequency of use of the unfamiliar word and the at least one word variant. Note, similar results are shown in the second diagram of page 4 of Exhibit A, which indicates that hits are presented as the "Results" of the preceding search. Similarly, the textual explanation of presenting information corresponding to the frequency of use of the unfamiliar word and the at least one word variant to the user (i.e., "It will then recommend the most likely spelling based on the number of search results") appears in the first paragraph of page 3 of Exhibit A and the first paragraph of Exhibit B. Additionally, the teaching of "This process for checking a word based on its "Internet popularity" allows a spell checker to have a recommendation for almost any word. . ." appears in the second paragraph of page 3 of Exhibit A and the second paragraph of Exhibit B.

Notably, conception must be shown at least with respect to the features in the cited reference relied upon for rendering the claimed invention unpatentable. In this regard, since the features recited in Applicants' independent claims (as shown by the example of independent claim 1 above) are fully supported by facts set forth in the Declaration,

Applicants respectfully assert that conception of the invention has been properly shown for the purpose of swearing behind the *Google* reference.

II.   Diligence

The Declaration indicates that Applicants exercised diligence from a period prior to the effective date of the cited reference (May 23, 2001) through the filing date of the pending application. For example, David Risley, Esquire of Thomas, Kayden, Horstemeyer & Risley corresponded with at least one of the inventors and began preparation of a draft patent application for review in April 2001 (*see* Declaration at item 7). By the end of April 2001, the inventors had reviewed and approved the final draft of the application (*see* Declaration at item 8). On May 4, 2001, the final draft of the application was sent to the Hewlett-Packard legal department for review by David Risley (*see* Declaration at item 9). After reviewing the inventor-approved final draft of the application, the Hewlett-Packard legal department requested the inventors to review the application and declaration and sign the declaration so that the application could be filed (*see* Declaration at item 10). The inventors reviewed the application and signed the declaration on May 29, 2001 so that the application could be filed with the U.S.P.T.O. (*see* Declaration at item 11). The patent application that is now identified as the '940 application was filed with the U.S.P.T.O. on June 15, 2001 (*see* Declaration at item 12).

Based on the foregoing, it is respectfully asserted that the Applicants exercised diligence from a period prior to the effective date of the cited reference (May 23, 2001) through the filing date of the pending application. Additionally, all facts relied upon to show conception and diligence took place in the United States (*see* Declaration at item 13). Since Applicants have shown conception of the claimed invention prior to the effective date of the *Google* reference and that Applicants exercised diligence from a period prior to the effective

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date of the *Google* reference through constructive reduction to practice of the invention, as evidenced by the filing of the present application, Applicants respectfully request that the *Google* reference be removed.

Since the remaining cited references, either individually or in combination, do not teach or reasonably suggest the features/limitations recited in the pending claims, as described in detail below, Applicants respectfully assert that all pending claims are in condition for allowance.

Rejections Under 35 U.S.C. §103

The Office Action indicates that claims 1 – 3, 5 – 8, 10 – 12, 14 – 17 and 19 - 20 stand rejected under 35 U.S.C. 103(a) as being unpatentable over *Google* and further in view of *Nielsen*. Additionally, the Office Action indicates that claims 4, 13 and 18 stand rejected under 35 U.S.C. 103(a) as being unpatentable over *Google* in view of *Nielsen* and further in view of *Lawrence*.

In this regard, claim 1 recites:

> 1.   *A computer-implemented method for checking the spelling of words in a document during performance of an automated spell check of the document, comprising:*
> *identifying an unfamiliar word in the document;*
> *generating at least one alternative spelling of the unfamiliar word to create a word variant;*
> providing the unfamiliar word and the at least one word variant to a search engine configured to search for a frequency of use of the unfamiliar word and the at least one word variant; and
> *presenting information corresponding to the frequency of use of the unfamiliar word and the at least one word variant to the user.*
> (Emphasis Added).

Applicants respectfully assert that the cited art does not teach or reasonably suggest at least the features/limitations emphasized above in claim 1. In particular, since *Google* may not be properly applied for the purpose of rendering claim 1 unpatentable and because none of

the other cited references teaches or reasonably suggests (either individually or in combination) at least the features emphasized above in claim 1, Applicants respectfully assert that claim 1 is in condition for allowance.

Since claims 2 – 6 and 8 – 10 are dependent claims that incorporate all the features/limitations of claim 1, Applicants respectfully assert that these claims also are in condition for allowance. Additionally, these claims recite other features/limitations that can serve as an independent basis for patentability.

With respect to claim 11, that claim recites:

> 11. A system for checking the spelling of words, comprising:
> *means for identifying an unfamiliar word in a document during performance of an automated spell check of the document;*
> *means for generating at least one alternative spelling of the unfamiliar word to create a word variant;*
> means for providing the unfamiliar word and the at least one word variant to a search engine configured to search for a frequency of use of the unfamiliar word and the at least one word variant; and
> *means for presenting information corresponding to the frequency of use of the unfamiliar word and the at least one word variant to the user.*
> (Emphasis Added).

Applicants respectfully assert that the cited art does not teach or reasonably suggest at least the features/limitations emphasized above in claim 11. In particular, since *Google* may not be properly applied for the purpose of rendering claim 11 unpatentable and because none of the other cited references teaches or reasonably suggests (either individually or in combination) at least the features emphasized above in claim 11, Applicants respectfully assert that claim 11 is in condition for allowance.

Since claims 12 – 15 are dependent claims that incorporate all the features/limitations of claim 11, Applicants respectfully assert that these claims also are in condition for allowance. Additionally, these claims recite other features/limitations that can serve as an independent basis for patentability.

With respect to claim 16, that claim recites:

> 16. A computer readable medium including a program for checking the spelling of words, comprising:
> *logic configured to identify an unfamiliar word in a document during performance of an automated spell check of the document;*
> *logic configured to generate at least one alternative spelling of the unfamiliar word to create a word variant;*
> logic c onfigured t o p rovide t he u nfamiliar w ord a nd t he a t l east one word variant to a search engine configured to search for a frequency of use of the unfamiliar word and the at least one word variant; and
> *logic configured to present information corresponding to the frequency of use of the word and the at least one word variant to the user.*
> (Emphasis Added).

Applicants respectfully assert that the cited art does not teach or reasonably suggest at least the features/limitations emphasized above in claim 16. In particular, since *Google* may not be properly applied for the purpose of rendering claim 16 unpatentable and because none of the other cited references teaches or reasonably suggests (either individually or in combination) at least the features emphasized above in claim 16, Applicants respectfully assert that claim 16 is in condition for allowance.

Since claims 17 – 20 are dependent claims that incorporate all the features/limitations of claim 16, Applicants respectfully assert that these claims also are in condition for allowance. Additionally, these claims recite other features/limitations that can serve as an independent basis for patentability.
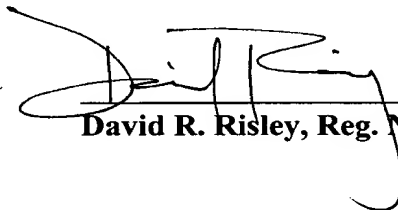
Cited Art Made of Record

The cited art made of record has been considered, but is not believed to affect the patentability of the presently pending claims.

CONCLUSION

In light of the foregoing amendments and for at least the reasons set forth above,

Applicants respectfully submit that all objections and/or rejections have been traversed,

rendered moot, and/or accommodated, and that the pending claims are in condition for

allowance. Favorable reconsideration and allowance of the present application and all

pending claims are hereby courteously requested. If, in the opinion of the Examiner, a

telephonic conference would expedite the examination of this matter, the Examiner is invited to

call the undersigned attorney at (770) 933-9500.
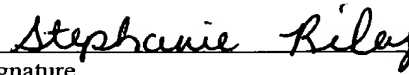
Respectfully submitted,

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